

REMARKS/ARGUMENTS

This is in Response to the Office Communication of July 31, 2006. Reconsideration and allowance of the instant application are respectfully requested. No new matter is added. Claims 1-20 remain in this application.

Double Patenting Response

Claims 1-12 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of USSN 11/193,460 or 11/193,483 and; claims 13-20 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of USSN 11/193,460 or 11/193,483 in view of US Patent No. 6,016,110.

Despite the apparent differences between the claims, Applicants have filed herewith a Terminal Disclaimer rendering these rejections moot. Accordingly, applicants request these rejections be withdrawn.

Claims 1-12 are Allowable

Claims 1-12 were allegedly rejected under 35 U.S.C. 103(a) under a combination of U.S. Patent No. 6,555,768 and Naoyuki (JP 2000-200147). The rejection is respectfully traversed.

Claim 1 recites, among other features, a sensor for detecting an **extension force** based on the pivotal movement of said rotatable member about the second axis for scrolling the image in a second scrolling direction perpendicular to the first scrolling direction, wherein the image is operable to scroll in the second direction responsive to the detected extension force.

The '768 Patent does not teach or suggest a sensor for detecting an **extension force** based on the pivotal movement of said rotatable member about the second axis for scrolling the image in a second scrolling direction perpendicular to the first scrolling direction, wherein the image is operable to scroll in the second direction responsive to the detected extension force.

The '768 Patent merely has contacts 8 and 9 which work on depression or a depressing the contacts.

Two actuator contacts (8 and 9) are positioned below the roller member and depressing corresponding parts of the roller member activates either or both contacts.

It is an essential aspect of the present invention that the roller key in excess of the navigation possibilities in rolling or scrolling, provides switch signal outputs corresponding to at least four different logic states, as illustrated in Table 1 below. This is achieved by having at least two actuator contacts, which can be depressed individually or simultaneously by depressing corresponding parts of the roller member.

“768 Patent, Col. 5, lines 56-68

There is no extension force based sensing and the recited scrolling based on the sensing.

In addition, the figure pointed to in the Office Action does teach or suggest the recited features of the claim 1. Figure 1 below of the ‘768 Patent is reproduced below.

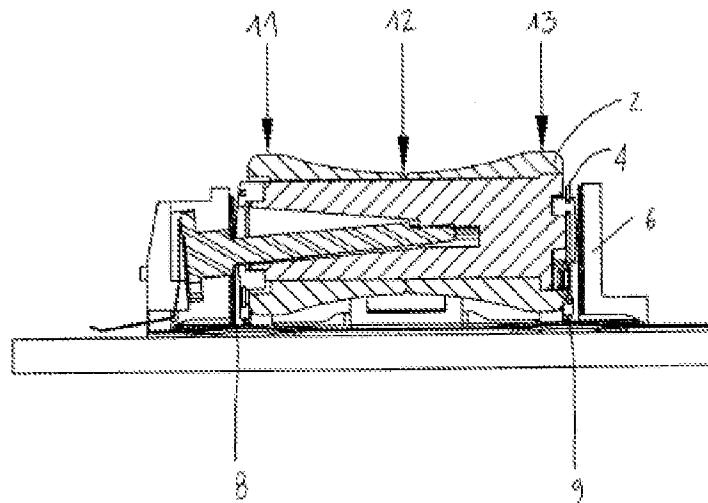


Fig. 1

As can be seen in FIG. 1 of the ‘768 Patent, it is devoid of a **sensor for detecting an extension force based on the pivotal movement of said rotatable member about the second axis** for scrolling the image in a second scrolling direction perpendicular to the first scrolling direction. Indeed, the ‘768 Patent fails to teach or suggest an extension force at all. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837

F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because the examiner ignored a claimed limitation that was absent from the reference). Furthermore, functional limitations must be evaluated and considered, just like any other limitation of a claim. See MPEP § 2173.05(g).

Naoyuki merely discloses a scroll wheel and a stick but fails to teach or suggest scrolling an image in a second direction responsive to a detected extension force. Indeed, Naoyuki fails to teach or suggest an extension force at all. It is respectfully asserted that motivation for combining Naoyuki with the '768 Patent is lacking. There is no teaching in the '768 Patent, nor any suggestion of scrolling an image in a left or right direction. The '768 Patent is completely silent as the scrolling in the left and right direction. There is no suggesting of "viewing more information in a horizontal direction on a display" (Office Action, pg. 9). This alleged is merely a generally unsupported allegation having the benefit of the applicants' inventive disclosure. Because the combination of the '768 Patent and Naoyuki fails to teach or suggest claim 1, it is respectfully submitted that claim 1 is allowable over the cited references.

Claims 2-8 depend from claim 1 and are allowable for at least the reasons set forth above for claim 1. Therefore, withdrawal of the rejection is respectfully requested.

Claim 9, recites among other features, sensing one of a first tensile force and a second tensile force based on the lateral pressure applied to the rotatable member, the second tensile force being greater than the first tensile force; and scrolling the image on the display screen in an approximately horizontal direction on the display screen, wherein the scrolling is at a first rate responsive to sensing the first tensile force and at a second rate responsive to sensing the second tensile force, the first rate being less than the second rate.

The '768 Patent does not teach or suggest a **first tensile force** or a **second tensile force** based on the lateral pressure applied to the rotatable member, the second tensile force being greater than the first tensile force. Indeed, the '768 Patent fails to teach or suggest a **tensile force at all for scrolling**. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit

held a reference did not render the claimed combination obvious because the examiner ignored a claimed limitation that was absent from the reference). Additionally, the '768 Patent and Naoyuki fails to teach or suggest the recited features of wherein the scrolling is at a first rate responsive to sensing the first tensile force and at a second rate responsive to sensing the second tensile force, the first rate being less than the second rate.

Claims 10-12 depend from claim 9. Therefore, it is respectfully submitted that the rejection of claims 9-12 should be withdrawn.

Claim 13-20 are Allowable

Claims 13-20 were allegedly rejected under 35 U.S.C. 103(a) under a combination of U.S. Patent No. 6,555,768 and Naoyuki (JP 2000-200147) and U.S. Patent No. 6,016,110. The rejection is respectfully traversed.

Claim 13 recites, among other features, a sensor for detecting pivotal displacement of the scroll wheel relative to the housing for a continuous period of time, wherein the image scrolls in the second direction at a first speed if the continuous period of time is less than or equal to a predetermined period of time, otherwise, the image scrolls at a second speed, the second speed being greater than the first speed.

It is respectfully asserted that motivation for combining Naoyuki with the '768 Patent is lacking. Naoyuki merely discloses a non-rotatable stick 212 that can be moved in multiple directions and a scroll wheel 202 that is rotatable in a rotating plane. However, Naoyuki fails to teach or suggest detecting displacement of a scroll wheel for a continuous period of time and scrolling an image at a first speed or second speed depending on the continuous period of time. Motivation is lacking to combine the '110 Patent with the '768 Patent and Naoyuki. There is no teaching in the '768 Patent, nor any suggestion of scrolling an image in a left or right direction. The '768 Patent is completely silent as the scrolling in the left and right direction. Further, the '110 patent is directed to automobile devices. As clearly held by the U.S. Court of Appeals for the Federal Circuit, "[i]t is impermissible to use the claimed invention as an *instruction manual or "template" to piece together* the teaching of the prior art ... [o]ne cannot use hindsight construction to pick and choose among isolated disclosures ... to deprecate the claimed invention." *In re Fritch* , 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075,

5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). (See also M.P.E.P. 2142). Hence, the Office has failed to state a supported case of *prima facie* obviousness.

Therefore, it is respectfully submitted the rejection of claim 13 should be withdrawn. Claims 14-16 depend from claim 13 and are allowable for at least the reasons set forth for claim 13.

Regarding claim 17, as set forth above, the '768 Patent fails to teach or suggest various features. The '768 Patent, either alone or in combination with Naoyuki, fails to teach or suggest claim 17. The '768 Patent also fails to teach or suggest a sensor positioned within said housing for sensing a period of time of lateral displacement of the rotatable member or a signal to scroll the image across the display screen at a first speed if the period of time is less than or equal to a predetermined period of time, otherwise scrolling the image at a second speed, the second speed being greater than the first speed as recited in claim 17.

There is no teaching in the '768 Patent, nor any suggestion of scrolling an image in a left or right direction. The '768 Patent is completely silent as the scrolling in the left and right direction. Motivation to combine the '768 Patent is completely lacking. Claims 18-20 depend from claim 17 and are allowable for at least the reasons set forth above for claim 17.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: November 21, 2006

By: /Darrell G. Mottley/
Darrell G. Mottley
Registration No. 42,912

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001